REMARKS

Claims 1, 3-6, 9-10, and 15-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Number 5,018,060 to Gelb et al. (hereinafter "Gelb") in view of United States Patent Number 5,757,571 to Basham et al. (hereinafter "Basham"). Claims 7, 11, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham and in further view of United States Patent Application Publication Number 2003/0204672 by Bergsten (hereinafter "Bergsten"). Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham and in further view of Bergsten and "Active Storage for Large-Scale Data Mining and Multimedia" Proceedings of the 24th VLDB Conference, New York, USA, 1998 by Erik Riedel et al. (hereinafter "Riedel").

Claim 7 is amended with the limitation of claims 1 and 15 that data is received "...from a dataset from an application that does not support scaling." Claim 7. Applicants have also amended independent claims 1, 7, and 15 to specify that a data set is to be stored exclusively on a magnetic tape storage medium. The amendment is well supported by the specification, which only teaches storage on magnetic tape. Page 9, Paragraph 30; Fig. 1, Ref. 112.

Response to rejections of claims under 35 U.S.C. § 103(a)

Claims 1-6, 8-10, and 15-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham. Claims 7, 11, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham and in further view of Bergsten. Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in

view of Basham and in further view of Bergsten and Riedel. Applicant respectfully traverses these rejections.

Claims 1, 7, and 15 include the limitation "...receive a dataset from an application that does not support scaling..." Claim 1. See also claims 7 and 15. The invention allows data from applications that do not support scaling to be scaled.

The Examiner argues that Basham teaches tape scaling and Applicants agree. However, Basham does not teach receiving a dataset from an application that does not support scaling. Scaling is logically limiting the capacity of the magnetic tape in order to increase performance. Page 10, Paragraph 35. Basham teaches that when a task input for writing a dataset to magnetic tap is received, the task input specifies either fixed or variable partitioning for the dataset, wherein the variable partitioning is equivalent to scaling. Basham, Col. 12, Lines 43-57; Fig. 7, Ref. 702, 706. Thus applications communicating datasets to the method and system of Basham must specify scaling to store the dataset or the method and system will not scale the dataset. Application support for scaling is required by Basham.

Applicants therefore submit that Basham does not teach the element of receiving a dataset from an application that does not support scaling. Gelb also does not teach receiving a dataset from an application that does not support scaling. Applicants assert that claims 1 and 15 are therefore allowable as Gelb and Basham do not disclose all of the claimed elements.

Applicants submit that as amended, claims 1, 7, and 15 are further differentiated from Gelb and Basham in that Gelb teaches defining data classes, storage classes, management classes, and storage groups, with storage requests matched to data, storage, and management classes, and

assigned a storage group. Gelb, Abstract. Data storage in storage devices is allocated based on a class and group. Gelb, Abstract. Thus Gelb teaches selecting the type of data storage including magnetic tape as noted earlier by the Examiner. Office Action of August 16, 2006, Page 2, Lines 14-17. In contrast, the present invention claims a dataset directed exclusively to a magnetic tape storage medium, so that there is no selecting of data storage as in Gelb. Instead, claims 1, 7, and 15 include the limitation "…select a storage instruction in response to storage criteria applied to the storage characteristics, wherein the storage instruction comprises an instruction to scale the magnetic tape storage medium to a predefined capacity …" Claim 1. See also claims 7 and 15. Thus the present invention claims selecting scaling in response to storage criteria while Gelb teaches selecting storage devices in response to storage criteria. Basham does not teach selecting scaling in response to storage criteria. Because of the significant difference between selecting scaling and selecting storage devices, Applicants therefore assert that Gelb and Basham do not disclose all of the elements of claims 1, 7, and 15, and that claims 1, 7, and 15 are allowable.

As a result of the presented remarks, Applicants assert that independent claims 1, 7, and 15 are in condition for prompt allowance. Applicants have not specifically traversed the rejections of dependent claims 3-6, 9-14, and 16-20 under 35 U.S.C. § 103(a), but believe those claims to be allowable for depending from allowable claims. See, *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Should additional information be required regarding the traversal of the rejections of the claims enumerated above, Examiner is respectfully asked to notify Applicants of such need. If

any impediments to the prompt allowance of the claims can be resolved by a telephone

conversation, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,

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